

REMARKS/ARGUMENTS

Claims 7-10 have been added, support for which exists, *inter alia*, at page 4, line 17, and page 7, lines 1-16.

Claims 4 and 6-10 are currently pending.

The Office Action rejected claim 4 under 35 U.S.C. § 102 as anticipated by U.S. patent 4,978,765 (“Sasaki”), and claim 6 under 35 U.S.C. § 102 as anticipated by, or in the alternative, under 35 U.S.C. § 103 as obvious over, Sasaki. In view of the following comments, Applicants respectfully request reconsideration and withdrawal of these rejections.

The pending rejections are based upon the assumption that the value for B/A required by the pending claims is an inherent feature of Sasaki’s catalysts. However, this assumption is incorrect and improper. Because the rejections are based upon this assumption, it follows that the pending rejections are also incorrect and improper. Accordingly, Applicants respectfully request reconsideration and withdrawal of the pending rejections.

The present invention relates to a novel catalyst which, as demonstrated in the examples of the present application, allows for improved production efficiencies during the synthesis of acrylonitrile.

As more fully explained at pages 5-6 of Applicants’ previous response, the manner by which the novel catalyst of the present invention is prepared differs from Sasaki’s preparation process. For example, the processes associated with the present invention include having a small difference between temperatures near the inlet and near the outlet, preferably in the range of 20-60°C. (See, discussion of step (6) at page 6 of Applicants’ previous response). Sasaki neither teaches nor suggests such processes. For example, Sasaki discloses that the temperature differential discussed above is 160°C. (See, page 6 of Applicant’s previous

response). Thus, it is clear that Sasaki neither teaches nor suggests the same processes disclosed in the present application. It does not appear that this fact is in dispute. Rather, it appears that the dispute focuses on the effect the different processes have on the resulting catalysts prepared from such processes.

The Office Action asserted that the B/A value is an inherent property to the catalyst, meaning that Sasaki's catalysts and the invention catalysts would have the same B/A values regardless of their methods of preparation. This assertion is incorrect. As demonstrated in example 1 and comparative example 1 of the present application, catalysts prepared according to the methods in the present application have a low B/A value satisfying the claim requirements (for example, example 1), whereas catalysts prepared via other methods including an large inlet/outlet temperature differential do not (for example, comparative example 1). Thus, Applicants have demonstrated that B/A value is not an inherent property regardless of preparation method. Accordingly, Sasaki's catalysts which are indisputably prepared by different methods than the claimed invention cannot be said to inherently possess the same B/A values as required by the pending the claims. The evidence of record directly rebuts this assertion.

Furthermore, Applicants note the attached precedential opinion from the Board of Patent Appeals and Interferences in *Ex parte Whalen* (Tab A). In *Whalen*, the Examiner's obviousness rejection was based on the reasoning that a person of ordinary skill in the art would have been motivated to optimize a specific property of prior art embolizing compositions (viscosity) because he would have had a reasonable expectation of success in achieving the safest clinical outcome and avoiding transvenous passage of the embolizing composition. (Pages 13-14). The Board rejected this reasoning, and concluded that the Examiner had not made out a *prima facie* case of obviousness.

Initially, the Board noted that “while discovery of an optimum value of a variable in a normal process is normally obvious, this is not always the case. One exception to the rule is where the parameter optimized was not recognized in the prior art as one that would affect the results.” (Page 14).

The Board explained that the Examiner had not pointed to any teaching in the cited references, or had not provided any reasoning based on scientific reasoning, that would support the conclusion that it would have been obvious to optimize the prior art embolizing compositions by increasing viscosity to the levels required by the claims. In fact, the Board stated, the prior art suggested a low viscosity was desired (pages 14-15), leading the Board to conclude that “in our view, none of the cited references would have led a person of ordinary skill in the art to modify the known embolic compositions by increasing their viscosity...” (Page 15).

Following *Whalen*, it is clear that Sasaki does not teach or suggest the invention catalyst. Sasaki neither teaches, suggests nor recognizes the importance of the required B/A value. Also, no apparent reason to supplement Sasaki’s teachings to modify the catalyst preparation method disclosed therein to arrive at the invention catalysts would have existed (just as no apparent reason to increase viscosity existed in *Whalen*). Accordingly, Sasaki cannot teach or suggest the claimed catalysts -- it would not have been taught or suggested to optimize Sasaki’s catalysts by modifying their preparation methods in such a way to yield catalysts having the required B/A properties set forth in the claims.

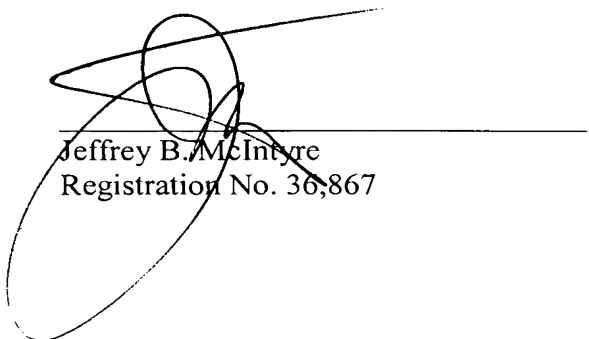
For all of the above reasons, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §§ 102 and/or 103.

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Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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